

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks.

Claims 1, 2, 7-12, and 21-27 are pending in the application. Claims 3-6, and 13-20 were previously canceled without prejudice to or disclaimer of the subject matter recited therein. Claims 1, 11, 21, 23, and 25 are amended. Claim 27 is newly added. Support for the claim amendments and additions can be found in the original specification at least at paragraph [0011]. No new matter has been added.

35 U.S.C. §112 Claim Rejections

Claims 9 and 10 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully traverses the rejection. Nevertheless, without conceding the propriety of this rejection, claim 1 has been amended for clarification. Accordingly, Applicant respectfully requests that the §112 rejection be withdrawn.

35 U.S.C. §102 Claim Rejections

Claims 1, 7, 8, 11, and 12 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 1,689,170 to Farmer (Farmer). Nevertheless, without conceding the propriety of this rejection, and in the interest of expediting allowance of the application, claim 1 has been amended for clarification. Accordingly, Applicant respectfully requests that the §102 rejection be withdrawn.

Independent claim 1 as presently presented recites, among other things, “a line comprising at least one of an electrical wire and a communication wire.” Further, claim 1 recites “a plurality of linked mounts repositionable relative to one another with an inner dimension sized to receive the line, the line being coupled to the plurality of linked mounts.”

Farmer is directed to “an appliance that is designed for use for lifting or for lowering the cylinders of internal combustion engines that are equipped with spark plugs for ignition purposes” (col. 1, lines 1-8). However, Farmer lacks “a line comprising at least one of an electrical wire and a communication wire” and “a plurality of linked mounts repositionable relative to one another with an inner dimension sized to receive the line, the line being coupled to the plurality of linked mounts,” as presently recited in claim 1. For at least the foregoing reasons, claim 1 is allowable over Farmer.

Dependent claims 7, 8, 11, and 12 depend from independent claim 1, and each is allowable by virtue of its dependency from the respective base claim, as well as for the additional features that it recites.

35 U.S.C. §103 Claim Rejections

I. Claims 1, 7-9, 11, and 12 were rejected under 35 U.S.C §103(a) as being obvious over U.S. Patent No. 4,171,123 (Woelkers), in view of Farmer and U.S. Patent No. 5,517,785 (Sawaf). Applicant respectfully traverses this rejection, because (A) assuming, for the sake of argument, that there is motivation to combine the cited documents, the combination still lacks important features of the claimed invention, and (B) there is no motivation to combine the cited documents as proposed in the Office Action.

(A) The cited documents whether taken alone or in combination (assuming, for the sake of argument, that they can even be combined as suggested in the Office Action) fail to disclose or suggest important features of the claimed invention.

Independent claim 1 is directed to an apparatus for pulling line through a raceway, and presently recites, among other things, “a line comprising at least one of an electrical wire and a communication wire” and “a plurality of linked mounts repositionable relative to one another with an inner dimension sized to receive the line, the line being coupled to the plurality of linked mounts.” As discussed further below, the cited documents lack such features.

Woelkers is directed to a conductor pulling device and teaches “a wire or conductor pulling device specifically used to pull conductors through a conduit” (abstract and col. 1, lines 53-63). The conductor-pulling device comprises “an elongated strip of material having a plurality of spaced openings 24 therealong for independently receiving respective conductors” (col. 3, lines 28-31). According to Woelkers, the pulling member 14 “has a flat planer configuration” and “is made of flexible material in order to allow the strip 14 to be pulled around curves or bends in the conduit 16” (col. 4, lines 9-12). However, there is no disclosure or suggestion in Woelkers of “a plurality of linked mounts repositionable relative to one another with an inner dimension sized to receive the line, the line being coupled to the plurality of linked mounts,” as presently recited in claim 1.

Sawaf teaches “a bottom trawl attached to a towing vessel located at the surface of the ocean, sea, bay or the like for the purpose of bottom trawl fishing and more particularly, to a sweepline system for connection to a series of hanging chains depending from such bottom trawl” (col. 1, lines 4-11). However, Sawaf fails to remedy the deficiencies in Woelkers noted above with respect to claim 1. In particular, Sawaf lacks any teaching of “a plurality of linked

mounts repositionable relative to one another with an inner dimension sized to receive the line, the line being coupled to the plurality of linked mounts,” as presently recited in claim 1.

Farmer teaches “an appliance that is designed for use for lifting or for lowering the cylinders of internal combustion engines that are equipped with spark plugs for ignition purposes” (col. 1, lines 1-8). However, Farmer also fails to remedy the deficiencies in Woelkers noted above with respect to claim 1. In particular, Farmer lacks any teaching of “a plurality of linked mounts repositionable relative to one another with an inner dimension sized to receive the line, the line being coupled to the plurality of linked mounts,” as presently recited in claim 1. Moreover, Farmer also fails to teach or suggest “a line comprising at least one of an electrical wire and a communication wire,” as also presently recited in claim 1. Rather, Farmer is concerned with chains used in an engine lifter.

Thus, even if, for the sake of argument, the cited references could be combined, the resulting system still would lack the features of independent claim 1. Accordingly, claim 1 is allowable over Woelkers, Farmer and Sawaf taken singly or in combination.

Dependent claims 7-9, 11, and 12 depend from independent claim 1, and are allowable by virtue of this dependency, as well as for the additional features that they recite.

(B) In addition, one of ordinary skill in the art would not have been motivated to modify the line puller of Woelkers in view of the teachings of Sawaf and Farmer, because Farmer and Sawaf are non-analogous art. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” MPEP 2141.01(a) (citing *In re Oetiker*, 977 F.2d 1443, 1446, 24

USPQ2d 1443, 1445 (Fed. Cir. 1992)). Here, neither Sawaf nor Farmer is in the field of Applicant's endeavor (e.g., line pullers), nor pertinent to the particular problem with which the inventor was concerned (e.g., securing one or more electrical or communications wires to apertures of a line puller). Thus, one of ordinary skill in the art would not have been motivated to look to Sawaf or Farmer to modify the line puller of Woelkers. Applicant requests withdrawal of any rejections based on the combination of the teachings of Woelkers with Sawaf and/or Farmer, for at least this additional reason.

Dependent claim 2 depends from independent claim 1, and is allowable by virtue of its dependency from the respective base claim, as well as for the additional features that it recites.

II. Claim 10 was rejected under 35 U.S.C §103(a) as being obvious over Woelkers, Farmer, and Sawaf, and further in view of U.S. Patent No. 6,193,217 (Zimmer).

Claim 10 depends from independent claim 1 and, therefore, includes all the features of that claim.

Zimmer was cited for its teaching that lines may be releasably attached to a line pulling device by tape, but fails to remedy the deficiencies in Woelkers, Farmer, and Sawaf note above, with respect to independent claim 1. In particular, Zimmer lacks any teaching of “a plurality of linked mounts repositionable relative to one another with an inner dimension sized to receive the line, the line being coupled to the plurality of linked mounts,” as presently recited in claim 1. Accordingly, claim 10 is allowable over Woelkers, Farmer, Sawaf, and Zimmer, whether taken singly or in combination (assuming for the sake of argument that the documents can even be combined as suggested in the Office Action).

III. Claim 2 was rejected under 35 U.S.C. §103(a) as being obvious over Farmer.

Claim 2 depends from claim 1 and, therefore, includes all the features of that claim. As discussed above, Farmer fails to disclose or suggest “a line comprising at least one of an electrical wire and a communication wire” and “a plurality of linked mounts repositionable relative to one another with an inner dimension sized to receive the line, the line being coupled to the plurality of linked mounts,” as presently recited in claim 1. Thus, claim 2 is allowable over Farmer by virtue of its dependency from claim 1, as well as for the additional features that it recites.

IV. New claim

New claim 27 is presented to provide the application with an additional scope of protection commensurate with the original specification, and recites additional features not shown by the cited documents. For example, claim 27 recites “a line comprising at least one of an electrical wire and a communication wire” and “a plurality of linked mounts repositionable relative to one another with an inner dimension sized to receive the line and an outer dimension sized to fit within a raceway, wherein at least one linked mount of the plurality of linked mounts has the line positioned therethrough and releasably coupled thereto with tape.” Accordingly, claim 27 is allowable over the cited documents.

V. Rejoinder

Withdrawn claims 21-26 are withdrawn from consideration as being drawn to a non-elected species. “When all claims to the nonelected invention(s) depend from or otherwise require all the limitations of an allowable claim, applicant must be advised that claims drawn to

the nonelected invention have been rejoined and the restriction requirement has been withdrawn.” MPEP § 821.04(a). In this case, claims 21-26 have been amended to depend from independent claim 1. Claim 1 was previously indicated as being generic, and is believed to be in condition for allowance. Accordingly, Applicant requests rejoinder of the withdrawn claims.

Conclusion

For at least the foregoing reasons, claims 1, 2, 7-12, and 21-27 are in condition for allowance. Applicants respectfully request reconsideration and withdrawal of the rejections, rejoinder of the withdrawn claims, and issuance of a notice of allowance.

If any issue remains unresolved that would prevent allowance of this case, **the Examiner is requested to contact the undersigned attorney to resolve the issue.**

Respectfully submitted,

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